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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86610019
Applicant	Joshua F Morell
Applied for Mark	LOOPER
Correspondence Address	JOSHUA F MORELL OWNER 2016 HILLTOP RD FLOURTOWN, PA 19031-1615 UNITED STATES josh.morell@gmail.com
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Filer's Name	Joshua Morell
Filer's e-mail	josh.morell@gmail.com
Signature	/joshua morell/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Joshua F. Morell
Application Serial No.: 86/610,019
Mark: LOOPER (word mark)
Filing Date: April 25, 2015
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Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
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Sir:

Applicant / Appellant, Joshua F. Morell (“Morell” or “Applicant” or “Appellant”), files this opening appeal brief in support of my previously filed Notice of Appeal (filed on April 29, 2016). At the time of filing my notice of appeal, I also filed a Request for Reconsideration, which was denied on May 16, 2016, which resulted in resumption of this appeal process on May 18, 2016. This opening appeal brief is being submitted within the permitted sixty (60) days from the resumption of the appeal proceeding. Applicant is the owner of the pending, refused word mark, LOOPER, Application Serial No. 86/610,019, filed on April 25, 2015 (the “Mark”).

Legal Citations

1. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973);
2. *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003);
3. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976);
4. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997);
5. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Statement of the Issue on Appeal / Requested Action of the TTAB

Registration of the Mark (LOOPER), for use in connection with a series of athletic apparel goods under International Class 025, was finally refused by the Patent and Trademark Office on October 29, 2015, in view of an asserted likelihood of confusion with the mark, LOOPER, having U.S. Registration No. 1,120,964 (the “’964 Registration”), and used in connection with “leather goods-namely, purses, billfolds, belts and tool pouches; and handbags made of imitation leather,” all in International Class 018. The basis of the refusal was under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Applicant respectfully requests reversal of the refusal of the registration of my mark and allowance of my application and publication of the Mark for use with commercialization of the athletic apparel goods. Applicant contends that the use of the Mark with the noted goods in class 025 are sufficiently different and distinct from the cited registration used for goods in class 018, and that there is no likelihood of confusion.

Argument – Section 2(d) Likelihood of Confusion

The determination of the issue of likelihood of confusion is based on an analysis of the probative facts that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Moreover, of the several du Pont factors, it generally acknowledged that the primary, and often key considerations for a likelihood of confusion analysis, are the similarities and distinguishing aspects between (a) the marks, and (b) the similarities or differences between the specifically identified goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); see also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In the review of the goods at issue, the comparison must focus on the identifications included the application and the goods specifically identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 at n. 4 (Fed. Cir. 1993).

For the present consideration, there is no argument that the Mark, LOOPER, is the same as the cited ‘964 Registration for LOOPER. My pending applied-for mark looks and sounds like

the cited registration. However, with which to the type of goods are used (or to be used), where, and how the marks are used are substantively and significantly different.

As amended in my filing of April 28, 2016, the listing of goods with which I will be using my LOOPER mark includes:

“Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets” all in International Class 025.

More specifically, to address the issue raised by the Examiner, *I deleted any reference to belts* as a good or goods with which I would use my LOOPER mark.

By comparison, the ‘964 Registration continues today for a single class of leather-type goods. More specifically, the ‘964 Registration is noted as being used only in connection with

“leather goods – namely, purses, billfolds, belts and tool pouches; and handbags made of imitation leather” all in Int’l Class 018.

There is no reference to any clothing goods within the identified class 018 goods. The reference to “belts” is specifically connected to “belts and tool pouches,” and not to “belts” as a distinct good.

What is important to note regarding the ‘964 Registration is that when originally registered, the ‘964 Registration goods description included three different classes of goods: “watch straps” in International Class 014; “clothing belts” in International Class 025; and “leather good – namely, purses, billfolds, belts and tool pouches; and handbags made of imitation leather” in International Class 018. Thereafter, no later than June 2009, both classes 014 and 025 were *specifically deleted* and registration of the LOOPER mark in connection with watch straps and clothing belts *was cancelled*. Accordingly, by its own admission, the LOOPER

registration is *not used in connection with the commercialization of clothing belts or other goods in Int'l Class 025*.

Since at least June 2009, and continuing today, the '964 Registration is only used in connection with the commercialization of "leather goods" and more specifically in connection with the commercialization of "purses, billfolds, belts and tool pouches; and handbags made of imitation leather." This specific statement of an intent to "delete" class 025 and "clothing belts" from a description of goods the '964 Registration is to be used with, is very telling and important. It shows that the '964 Registration has not been, and is not now used with any goods related to the athletic apparel my Mark is to be used with, and that there is no reasonably likelihood of confusion.

More specifically, a direct comparison of the goods at issue, my LOOPER mark is not to be used in connection with the commercialization of any leather goods, purses, billfolds, belts, tool pouches, or handbags. Moreover, the class of goods the '964 Registration is identified with is "leather goods" while my LOOPER mark is to be used with "clothing" goods. A review of the goods the '964 Registration is identified with shows such goods are within the "leather" goods category, including purses, billfolds, belts, tool pouches, and handbags. The athletic clothing apparel with which I will be using my Mark are not leather goods, and not related at all to the type of goods identified with the '964 Registration.

While the Examiner states that "the other remaining proposed goods [in the pending application, other than belts] are related to the belt goods of the cited mark," I believe the Examiner has misread or misunderstands the '964 Registration description of goods. The reference to "belts" is not unitary, but is connected to tool pouches, or more specifically is stated as "belts and tool pouches." There is no comma after the word "belt" such as "belts, and tool pouches." That is a critical distinction and is very consistent with the specific goods that the '964 Registration owner has been using the LOOPER mark. As shown in the example advertisements presented by the owner of the '964 Registration, the LOOPER mark is used in connection with the sale of leather gun holsters and related leather items. No advertising by the owner of the '964 Registration showed any connection or reference or relation to clothing goods or athletic apparel.

With respect to channels of trade, as I have previously presented to the Examiner, there does not appear to be any direct website presence for the Looper leather goods. The current owner of the LOOPER registration, Looper Law Enforcement, LLC, appears to only commercialize products through limited third party sites. These sites are limited to advertising and showing leather pistol holsters. None of the sales sites showing Looper pistol holsters appear to show any goods that I will commercialize under my Mark, including athletic apparel, shirts, pants, jackets, footwear, hats and caps, golf shoes; sweat shirts; jackets; or sweaters.” Moreover, it is my intention to commercialize my products through my direct website on-line. Accordingly, the difference in the channels of trade between how the Looper registration products are sold, and how I intend to provide point-of-sale locations for my distinct products further differentiates and obviates any confusion.

In view of the limitation of the description of goods for my Mark, to remove any reference to belts, as well as there being no reference to any leather purses, billfolds, tool pouches, or handbags made of imitation leather, and the fact that the remaining goods identified in my description of goods have no relation to any of the LOOPER registration goods, there is no overlap nor any reasoned likelihood of confusion between the LOOPER registration and my Mark.

Conclusion

For the reasons provided herein, Applicant / Appellant respectfully requests that the Board reverse the Examiner’s refusal of registration of my Mark based upon an asserted likelihood of confusion with the ‘964 Registration. As provided above, the ‘964 Registration is not used in connection with any goods that are the same as or related to the goods with which I will be using my Mark. Moreover, the owner of the ‘964 Registration specifically cancelled use of their LOOPER mark in connection with clothing belts, and with respect to any goods within International Class 025, which is the only class of goods that my Mark is to be used. Please let me know of any questions I may be able to address.

Respectfully submitted,

Dated: July 17, 2016

/Joshua Morell/
Joshua F. Morell
2016 Hilltop Road
Flourtown, PA 19031